

REMARKS/ARGUMENTS

This response is being filed in reply to the Final Office Action mailed November 1, 2007. In that Action claims 1-25 and 48-54 were rejected, among others, under 35 U.S.C. 112, paragraph 1, for failing to comply with the written description requirement, and also under 35 U.S.C. 112, paragraph 2, for failing to particularly point out and distinctly claim the subject matter applicants regard as their invention. Applicants have since filed a Notice of Appeal on January 1, 2008. As such this response is governed by 37 C.F.R. 41.33, which allows the Examiner to admit Amendments that present rejected claims in a better condition for consideration on appeal. *See MPEP 1206(I).* Applicants believe this response accomplishes that goal by addressing the Examiner's 112 rejections and thus reducing the number of issues that must eventually be considered by the Board.

Claim Rejections – 35 U.S.C. § 112, first paragraph**A.**

Claims 1-25 and 48-54 were rejected under 35 U.S.C. 112, paragraph 1, for failing to comply with the written description requirement because of an inserted limitation that reads, according to the Final Office Action:

hydrophobic polyol biopolymer comprising an ester of
a fatty acid and glycerol...that...is present in (an
amount) up to 40 wt% of the total polyol component.

Final Office Action Mailed November 01, 2007, page 2.

Applicants would like to direct the Examiner to paragraph [0061] of the application and especially to Table 1B. There, Applicants show one example of a polyol component that comprises polyol biopolymers. More specifically, the polyol biopolymers disclosed in this example are castor oil and soy oil. And both castor oil and soy oil, as originally indicated in this application, happen to be a materials comprised of an ester of a fatty acid and glycerol. And furthermore, as indicated in paragraph [0019], the biopolymer (in this case castor oil and soy oil) may be present in an amount up to about 40 wt. % of the polyol component. Therefore, based on a reading of paragraph [0019] and Table 1B, one of ordinary skill in the art would understand the originally filed application to disclose a hydrophobic polyol biopolymer comprising an ester of a fatty acid and glycerol that is present in an amount up to 40 wt% of the total polyol component.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw this 112, first paragraph, rejection.

B.

Claims 1-25 and 48-54 were rejected under 35 U.S.C. 112, paragraph 1, for failing to comply with the written description requirement because of an inserted limitation that, according to the Final Office Action, calls for the “instantly claimed polyol being defined as a “biopolymer.” *Final Office Action Mailed November 01, 2007, page 3.*

Applicants would like to direct the Examiner to paragraphs [0001], [0019], and [0061] to show support in the originally filed application for the “biopolymer” limitation. In paragraph [0001] it is stated that this invention relates to rigid polyurethane foams that contain “one or more hydrophobic biopolymers, such as castor oil, soybean oil, and the like...” Paragraph [0019] then states that “a polyol component that is comprised of at least one biopolymer” may be used, and that “the biopolymer is preferably hydrophobic.” Also, paragraph [0061] and especially Table 1B shows an example of a polyol component that comprises castor oil and soy oil, which are identified as biopolymers comprised of an ester fatty acid and glycerol. Thus Applicants contend that a person of ordinary skill in the art would understand the as-filed application to disclose a polyol component that comprises a hydrophobic polyol biopolymer.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw this 112, first paragraph, rejection.

C.

Claims 1-25 and 48-54 were rejected under 35 U.S.C. 112, paragraph 1, for failing to comply with the written description requirement because of an “inserted limitation referring to a non-biopolymer. *Final Office Action Mailed November 01, 2007, page 3.*

Applicants maintain that the previous addition of the term “non-biopolymer” complied with 35 U.S.C. 112, paragraph 1, because a large class of polyols were disclosed in the originally filed application that do not qualify as biopolymers but nonetheless may be included in the polyol component. The claim terminology “a second polyol being a non-biopolymer” simply claimed these types of polyols. Thus the “non-biopolmer” claim limitation was appropriate given that negative claim limitations are not per se prohibited by the written description requirement, *Ex parte Park*, 30 U.S.P.Q.2d 1234, 1236 (Bd. Pat. App. & Int. 1994), and also that

one of ordinary skill in the art would have understood that the Applicants were in possession of the subject matter at the time the application was filed.

But in the interest of advancing prosecution, Applicants have deleted from independent claims 1, 10, and 19 the negative claim limitation “being a non-biopolymer” and substituted in the more affirmative terminology “derived from a petrochemical.” While this claim language is not explicitly recited in the application, those of ordinary skill in the art of polyurethane chemistry would understand that the Applicants were in possession of this claimed subject matter as of the application filing date. For instance, paragraphs [0020], [0021] through [0023], [0031], [0033], [0034], and [0035] each disclose polyols that are not biopolymers but are instead derived from petrochemicals. Even the Kurth reference, which is used here for the sole purpose of showing the general knowledge of persons of ordinary skill in the art as of the application’s filing date, identifies these types of polyols as being petroleum based or derived from petrochemicals. *See Kurth, Page 1 paragraphs [0007] and [0008]; Page 2 paragraph [0009].*

Applicants now believe this 112 written description rejection is overcome as the originally filed application discloses other polyols that qualify as a second polyol derived from a petrochemical that may be used to make the polyol component. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw this 112, first paragraph, rejection. The Examiner is urged to telephone Applicants’ undersigned attorney if this particular issue is not resolved by the current amendment.

Claim Rejections – 35 U.S.C. § 112, second paragraph

Claims 1-25 and 48-54 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for, according to the Final Office Action, “the omission of the terminology ‘an amount’ from Applicants’ claimed polyol range...” *Final Office Action mailed November 01, 2007, page 4.*

Applicants have amended independent claims 1 and 19 to include this omitted terminology. There was no need to amend independent claim 10 since it already contained such wording.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw this 112, second paragraph, rejection.

CONCLUSION

Applicants respectfully request entry of this amendment under 37 C.F.R. 44.33 and withdrawal of the 35 U.S.C. 112, first paragraph, and 35 U.S.C. 112, second paragraph, rejections raised in the Final Office Action mailed November 01, 2007. This would present the rejected claims in a better condition for appeal by significantly reducing the number of issues the Board must consider. The Examiner is invited to telephone the Applicant's undersigned attorney at (248) 689-3500 if any unresolved matters remain in connection with this response.

Also, any extension of time is hereby requested with the filing of this document. The Commissioner is authorized to charge this fee and any other fees, or credit any overpayment, to Deposit Account No. 04-1512 (Dow Global Technologies Inc.)

Respectfully submitted,

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